

REMARKS

Claims 1–24 and 51–79 are pending. Of these, claims 12 and 13 are amended to correct clerical errors. These amendment add no new matter.

Claims 1-24, 51-71, 78, and 79 stand rejected as being obvious over Zimmerman in view of Chiochetti. Claims 51-79 stand rejected as being obvious over Zimmerman in view of Chiochetti, Yeh, Lois, and Reynolds. In their April 7, 2003 Response to Final Office Action, applicants argue that the claimed invention is distinguishable over the cited art because it unexpectedly allows real time, whole body imaging of a mammal. See also applicants' August 2, 2002 Supplemental Remarks and the accompanying declaration of Dr. Robert Hoffman.

In the April 29, 2003 Advisory Action, the Examiner contends that applicants' arguments are unpersuasive because the "whole body imaging" property is not required by any of the claims. Applicants traverse.

It is well established in case law that arguments and/or evidence relied upon relating to unexpected results or advantages need not be disclosed in the specification, much less recited in a claim. As stated in the Manual of Patent Examining Procedure § 716.02(f):

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66, F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995)

In *In re Chu*, the CAFC held that:

We have found no cases supporting the position that a patent applicant's evidence or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in

some instances most significantly, the evidence and arguments proffered during the give-and-take of *ex parte* patent prosecution.

66 F.3d at 299, 36 USPQ2d at 1095.

M.P.E.P. § 716.02(f) also cites *In re Zenitz*, 33 F.2d 924, 928, 142 USPQ 158, 161 (CCPA 1964). In that case, the examiner rejected Zenitz's claimed compounds as obvious in view of the prior art. In response, Zenitz presented affidavits showing unexpected property of the claimed compounds. The court held that the affidavits established non-obviousness of the claimed compounds, because the unexpected property, though not disclosed at filing, would "inherently flow from" the disclosed property of the compounds. In fact, the court stated: "The after-discovery of unsuspected usefulness in a disclosed apparatus, far from detracting from its value, may serve to enhance it. It is the benefits which test, use, and time unfold that really determine merit."

In the instant application, applicants have provided arguments and experimental data to support their position that the subject matter of the instant claims is nonobvious in view of the prior art. The advantages of the instant invention—whole body imaging—are an inherent property of the claimed mammals. *Zenitz*. Under the case law discussed above, such properties or advantages are not required to be disclosed in the specification. Thus, that the "whole body imaging" property is not recited in the claims does not provide a proper basis for rejection.

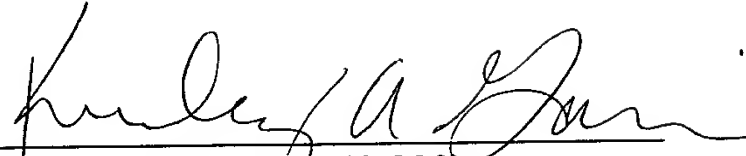
CONCLUSION

Applicants respectfully submit that claims 1–24 and 51–79 are in condition for allowance. Applicants invite the Examiner to telephone the undersigned if a telephonic

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discussion would facilitate resolution of outstanding issues in the case.

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